

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-6 are rejected under 35 U.S.C. 102 over the patent to Junkers.

Claims 6 and 8 are rejected under 35 U.S.C. 103 over the patent to Junkers.

The drawings are objected to and the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objections and rejections, applicant has submitted a copy of the drawings with the proposed correction and amended claim 1 as required by the Examiner.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant has somewhat amended claim 1, the broadest claim on file, to more clearly define the present invention.

It is respectfully submitted that the fluid-operated power tool defined in claim 1, clearly and patentably distinguish the present invention from the reference applied by the Examiner against the original claims.

It is believed to be advisable to first of all explain to the Examiner the subject matter of the present invention and the new features. In accordance with the applicant's invention as defined in claim 1, the reaction member formed as a reaction arm is turnable between a plurality of positions over 360° around the axis of the cylinder-piston unit of the power drive part of the tool. In contrast, in the patent to Junkers the reaction arm is turnable around 300° around the axis of the engaging element. The advantages of the fluid-operated tool in accordance with the present invention is that, by connecting the reaction arm to be turnable around the axis of the cylinder-piston unit, it becomes adjustable along the axis of the engaging element. In contrast in the tool of the Junkers patent the reaction arm is adjustable along the axis of the cylinder-piston unit.

With the fluid-operated tool designed in accordance with the present invention, when the tool is engaged in a socket the tool can make its reaction arm abut on the same plane as the nut to be turned or up and sideways of the nut, or on the opposite side of the engaging element to where the engaging element engages with the socket. In contrast with the tool disclosed in the reference, when the tool is engaged in a socket, it can

react merely anywhere around the axis of the nut to be turned. Thus, the reference applied by the Examiner against the original claims does not teach the new features of the present invention and the construction disclosed in reference does not provide for the highly advantageous results obtainable from the applicant's invention.

Also, claim 1 defines that the reaction arm has a projection which is insertable in the opening of the power drive part. The advantage of having the reaction arm engage splines in the opening of the power drive part or in other words inside the housing of the power drive part is that the tool can be used also without the reaction arm. In this case, the cylinder housing portion can just abut against a stationary object without destroying the normal hexagonal or spline outer contour of the cylinder housing and without indenting the abutment area. These new features of present invention which are now defined in claim 1 are also not disclosed in the reference applied by the Examiner and also can not be derived from it.

As explained above, the present invention as defined in claim 1 has new features which are not disclosed in the reference. A person skilled in the art can arrive at the applicant's invention only by substantial modification of the reference, in particular by inclusion into the new features which are not disclosed in it. However, it is known that in order to arrive at

a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest."

Definitely, the reference does not contain any suggestions for such a modification.

As explained herein above, the new features of present invention as defined in claim 1 provide for the highly advantageous results which can not be accomplished by the construction disclosed in the reference.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

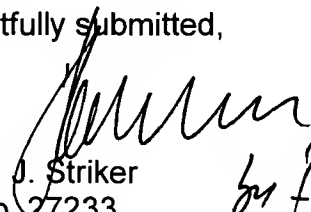
Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and it is respectfully submitted that these claims should be allowed as well.

Reconsideration and allowance of present application is most respectfully requested.

Respectfully submitted,

  
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*by Phoebe  
10/28/03*